

REMARKS

Claims 1 through 25 are pending in this application. The applicant greatly appreciates the examiner's indication of allowability concerning claims 2 through 12, 14, 15, and 17 through 20.

DOUBLE PATENTING

The examiner stated that claims 1, 13, 16, and 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,233,026. The examiner admits that the conflicting claims are not identical but states that they are not patentably distinct from each other.

The Federal Circuit held that obviousness-type double patenting rejections must include clear evidence to establish why an alleged variation of an invention claimed in a prior patent would have been obvious. *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678, 683 (Fed. Cir. 1986). Therefore, in order to establish a prima facie case of nonstatutory-type obviousness-type double patenting:

1. The examiner must identify the inventions claimed in the claims under consideration and in the patent claims;

2. The examiner must establish that any variation between the inventions claimed in the claims would have been obvious to a person of ordinary skill in the art. (The disclosure of a prior art patent or application may be used as a basis for rejection only to the extent that it is claimed. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (C.C.P.A. 1970)).

3. The examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness. *In re Longi*, 759 F.2d 887, 225 USPQ 645, 651 (Fed. Cir. 1985).

The examiner states that the upper fitting is substantially the same as seen by comparing figure 3 of the instant application and figure 3 of the patent. The upper fittings in figure 3 of the patent are not mentioned specifically in the claims of U.S. Patent 6,233,026. The Federal Court asked whether , “any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent.” *In re Vogel*, 164 USPQ at 622 (emphasis added). As mentioned above, the disclosure of a prior art patent or application may be used as a basis for rejection only to the extent that it is claimed. The entire disclosure is not available, and may not be used, in a prior art sense. Therefore, the disclosure of the upper fitting cannot be used against the present invention in obviousness type double patenting rejection.

The examiner mentions on page 4 of paper number 8 that the art shows the snapping of the shield to a case and since a monitor without a shield is well known in the art, it would have been obvious to make the same case without a shield and without the snap fittings with which it is secured. Column 1, lines 15-17 of U.S. Patent 6,233,026 mentions that the bottom shield which easily engages with a front case. The present invention specifically mentions the rear case snap fitting with the front case. Different parts may have varying physical forces which may require different structures. There is a structural difference between the disclosure of the prior art patent to the extent that it is claimed and the presently claimed invention.

Furthermore, respectfully, the examiner failed to show a motivation to combine the patent with a monitor without a shield. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999).

REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1, 16, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beak (U.S. Patent 5,863,106).

According to MPEP 706.02(j), a *prima facie* case of obviousness under 35 U.S.C. § 103 must be established by the examiner.

The examiner mentions that Beak discloses a monitor which includes an engaging pin (11 and 11') at the bottom of the front case which is received in a slot in the rear case (42, 42'). Respectfully, however, as pointed out in Beak in col. 3, lines 20-30, and lines 58-65, reference 11 and 11' holds a printed circuit board (PCB) 31 and not the rear case section. Member 42 and 42' do not receive reference 11 and 11', but they receive the printed circuit board 31. In col. 1, lines 1-10 of Beak, it mentions that the engaging pin relates to a structure affixing a printed circuit board within a monitor case. In col. 4, lines 36-40 of claim 1 of Beak, it states that the first guide affixes the printed circuit board. Therefore, Beak discloses a different structure than the present invention, and so does not teach or suggest the claimed present invention.

Further, the limitations from the combination expressed by the examiner are not equivalent to the present invention. The prior art references of the combination, must show substantially the same function in substantially the same way to achieve substantially the same result, and only then will the reference be considered an equivalent of the claimed invention to support an obviousness rejection. *Hilton Davis Chemical Co. v. Warner-Jenkins co.* 62 F.3d 1512, 35 USPQ 2d 1641, 1645 (Fed. Cir, 1995), *See Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ 2d 1737 (Fed.

Cir. 1987) (*en banc*). In *Beak* the result is stabilizing a printed circuit board, and in the present invention the result is stably engaging the front casing to a rear casing as mentioned in lines 14-16 of page 1 of the present invention.

In the response to the arguments, the examiner on page 4 of paper number 8 states that the unnumbered features around the case next to the actual number 11, not feature 11 are also engaging pins. However, if these are also engaging pins, then there is no mention of the snap pins. Even if the pins around the periphery and feature 11 are two different types of pins (one being the snap pin and the other the engaging pin), one pin does not prevent the other pin from detaching the front case from the rear case. It is not clear from the drawing alone that the pins around the periphery of the case can prevent the case from disengaging. As shown above, feature 11 is involved in holding the printed circuit board in place. Therefore, *Beak* does not teach or suggests a snap pin that prevents the engaging pin from detaching as mentioned in claim 1 of the present invention. Both the snap pin and the engaging pins connect between the front case and rear case. *Beak* does not teach or suggest both structures interacting together in the manner presented in the claims of the present invention.

ALLOWABILITY OF CLAIMS

The applicant greatly appreciates the examiner's indication of allowability pertaining to claim 2 through 12, 14, 15, and 17 through 20. In accordance with 37 C.F.R. § 1.111(b), the applicant respectfully requests that the examiner temporarily hold objections and requirements as to form in abeyance until the remarks and amendments in this Amendment are considered by the examiner.


Concerning claims 22-24, since the examiner agrees that the dependent claims such as claims

2 through 12, 14, 15, and 17 through 20 are allowable, claims 22 through 24 should also be allowable. For instance, claim 22 corresponds to claim 2, claim 23 corresponds to claim 3, claim 24 corresponds to claim 5.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Response. Should there be any other fees, the Commissioner is authorized to charge Deposit Account No. 02-4943 and advise the undersigned attorney accordingly.

Respectfully submitted,


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